

II. Claim Rejections

A. U.S. Patent Publication No. 2002/0046431 to *Laurent et al.* in view of U.S. Patent No. 5,868,800 to *Cotteret et al.*

The Examiner has rejected claims 1-56 under 35 U.S.C. § 103(a) as unpatentable over U.S. Patent Publication No. 2002/0046431 to *Laurent et al.* ("*Laurent*") in view of U.S. Patent No. 5,868,800 to *Cotteret et al.* ("*Cotteret*") for the reasons disclosed on pages 2-5 of the Office Action. Applicants respectfully traverse this rejection.

The Examiner contends that the combination of *Laurent* and *Cotteret* teach all the claim limitations of the present invention. At pages 2-4 of the Office Action, the Examiner exhaustively identifies the various dyeing ingredients and respective amounts disclosed in *Laurent* that are the same as those presently claimed. For example, according to the Examiner, *Laurent* teaches "at least one oxidation dye," "cationic poly(vinyl lactam) polymers," "direct dyes," and "at least one surfactant," etc. The Examiner notes, however, that although *Laurent* does disclose compositions comprising fatty acids, it does not teach the particular fatty acid that is recited in the present claims.

To cure this deficiency, the Examiner relies on the teachings of *Cotteret*. According to the Examiner, this patent discloses a hair dyeing composition containing the fatty acid recited in Applicant's claims, i.e., lauric acid. Thus, the Examiner concludes it would have been obvious to one skilled in the art to

incorporate the fatty acids of *Cotteret*, such as lauric acid, in *Laurent's* composition, with a reasonable expectation of success.

More specifically, the Examiner rests his conclusion of obviousness on at least three flawed theories. First, he contends that *Laurent* suggests the use of fatty acids in a dyeing composition. Second, he asserts that because *Cotteret* teaches a composition comprising lauric acid, a person of ordinary skill in the art "would be" motivated to incorporate fatty acids in a hair dyeing composition. Finally, the Examiner maintains that a reasonable expectation of success would have existed from such a combination. Applicants will address each of these flawed arguments below.

1. No Motivation Would Have Existed to Combine the Cited References

Simply because the teachings of *Cotteret* and *Laurent* both generally relate to dye compositions does not, by itself, mean that one skilled in the art would have combined the two. To properly combine two references, the prior art must suggest the desirability of the claimed combination. M.P.E.P. § 2143.01. The term "desirability" means more than just a passing statement, mere mention, or cursory description. Rather, this term means that the prior art must show that the invention was worth seeking or that it would have somehow been advantageous. Simply put, the prior art must provide some motivation or incentive to combine the cited references.

As explained by the M.P.E.P., this motivation or suggestion can derive from three sources: (1) the teachings of the prior art; (2) the nature of the problem to be solved; and (3) the knowledge of one skilled in the art. *Id.* Here, the Examiner mistakenly relies on the teachings of the prior art. But the explicit teachings of both references provide no evidence that the claimed invention would have been obvious to one of ordinary skill.

Turning to the primary reference - *Laurent* - the Examiner contends that this reference teaches the use of fatty acids in dyeing compositions. To support this contention, the Examiner points to the Example, at paragraph 0493, which lists oleic acid as a dye ingredient. Although this example may illustrate that oleic acid can be used in a dyeing composition, it provides no suggestion that incorporation of any other type of fatty acid would be beneficial, or even somehow advantageous in creating a dye composition.

One of the reasons why *Laurent* does not provide this suggestion is largely due to the problem the inventors sought to solve. In *Laurent*, the problem confronting the inventors was combining an oxidation dye composition and an oxidizing agent composition where the resulting color would not develop too quickly. Para. [0016]. This problem was solved by including a combination of particular materials in an oxidation dyeing composition. Para. [0017]. Notably, fatty acids are not mentioned as one of these materials. Rather, fatty acids are simply listed generally as an optional ingredient that can be used in *Laurent's*

composition. Para. [0466] ("The composition in accordance with the invention may further comprise an effective amount of at least one agent conventionally used in oxidation dyeing.").

Moreover, like *Laurent*, *Cotteret* lists lauric acid only as an optional dye ingredient. See Examples 1 and 2. The similarities do not stop there. Similar to *Laurent*, the problem the *Cotteret* inventors' sought to solve has nothing to do with the incorporation of a fatty acid in a dye composition. The inventors of *Cotteret* sought to prevent the color intensity problems that resulted when para-phenylenediamine derivatives were used in a dyeing composition. Col. 1, lines 43-55. The present inventors, after much research, discovered a series of novel dyes that provided improved intensity. Col. 1, lines 49-55. There is simply no teaching or suggestion that a fatty acid improved color intensity.

What can be concluded, then, is that it was known at the time of applicants' invention to use various types of fatty acids in a dyeing composition. But there is no suggestion in either reference that one skilled in the art would have selected lauric acid to replace any fatty acid, let alone, the oleic acid in *Laurent's* composition. When viewed as a whole, neither *Cotteret* nor *Laurent* provide any suggestion that these two ingredients are interchangeable. Or that the substitution would have resulted in an advantageous rather than disastrous dye composition. Rather, in both references the two different fatty acids are simply referenced but not in any way that would provide the requisite motivation

or suggestion to combine the two references. Desirability requires much more than a mere mention in a document or acknowledgment that each claim limitation is known. M.P.E.P. § 2143.01. Yet, the Examiner seems to turn a blind eye to that legal premise.

In fact, the present specification illustrates that various species of fatty acids would not result in a beneficial dyeing composition. In the Example, two different compositions were prepared - an inventive composition and a comparative composition. The comparative composition contains all the same dyeing ingredients - except lauric acid was substituted with stearic acid. Para. [0177]. Stearic acid comprises eighteen carbon atoms and thus does not read on the claim limitation "at least one fatty acid chosen from C₁₀-C₁₄ fatty acids." *Id.* The results indicate that the comparative composition was much less easy to prepare, less pleasant to apply, more difficult to remove, and resulted in inferior color quality. *Id.* Thus, clearly it would not have been obvious to substitute one fatty acid for another, as all fatty acid types do not produce the same results.

It is plainly apparent that the Examiner's rejection is guided by hindsight. This fact is evidenced by the Examiner's conclusion of obviousness in the Office Action: "a person of ordinary skill in the art *would be* motivated to incorporate fatty acids in the hair dyeing compositions. . . ." Office Action, page 4 (emphasis added). This statement is improper as the Examiner must determine what *would have been obvious* in view of the prior art - taking into account only the

knowledge that was within the level of one of ordinary skill in the art at the time the claimed invention was made. M.P.E.P. § 2145(X). Here, the Examiner includes in his analysis the teachings of the present specification. Accordingly, because the cited references would not have been properly combinable, Applicants submit that the rejection is improper.

2. No Reasonable Expectation of Success

Additionally, the Examiner ignores the Example that shows that success would not have been reasonably expected. This Example, as discussed above, illustrates, that different species within the fatty acid genus can yield very different results. Accordingly, it would not have been reasonable to conclude that the proposed substitution would either improve the performance of a dyeing composition or result in a composition with similar properties of that claimed. *Office Action*, page 5. In fact, the Example provides a graphic illustration that the opposite is true.

In the art of hair dyeing, which is notoriously unpredictable, the Examiner must do more than conclude, with no factual support, that one skilled in the art would have a reasonable expectation of success. See, e.g., Zviak, *THE SCIENCE OF HAIR CARE*, at 271-272 (Charles Zviak ed., 1986) ("any varying element can cause a major change"). Here, the Examiner has failed to point to any teachings or make any factual findings as to why a reasonable expectation of success would have existed. Until the Examiner provides convincing evidence on the

record, the rejection is improper and should be withdrawn. M.P.E.P. § 2143.02 (citing *In re Dow Chem. Co.*, 837 F.2d 469 (Fed. Cir. 1988) (noting that the Examiner must show why a person of ordinary skill in the art would have had a reasonable expectation of success when combining the references)).

B. Rejection of Claims 16-17, 22, and 41-42

Because neither *Laurent* nor *Cotteret* teach the presently claimed amounts for the cationic poly(vinylactam) (claims 16 and 17), fatty acids (claim 22), and surfactants (claims 41 and 42), the Examiner alleges that a person of ordinary skill in the art “would be motivated” to optimize the amounts of these ingredients. This rejection is improper for at least two reasons.

First, as discussed above, the Examiner’s rejection is clearly guided by hindsight. The proper standard for determining obviousness is not whether the claimed invention “would be” obvious but whether it would have been obvious to one skilled in the art at the time of applicant’s invention. Here, when considering *only Laurent* and *Cotteret*, in combination, nothing in either reference provides a motivation to optimize the cationic poly(vinylactam), the fatty acids, or the surfactants. Nor does the Examiner make any factual findings as to why one skilled in the art would have performed this optimization in the first place.

Secondly, because neither *Laurent* nor *Cotteret* provide a motivation to combine their respective teachings, the further contention of a motivation to

optimize amounts of ingredients is premature, and thus improper. Thus, for at least this additional reason, this rejection is improper.

C. Rejection of Claims 55-56

With respect to the multi-compartment kit claims, the Examiner contends that it would have been obvious to make a multicompartment kit because *Laurent* teaches a device or kit for dyeing hair comprising at least two compartments. *Office Action*, page 5. In response, Applicants submit that even if *Laurent* discloses a device or kit for dyeing hair, neither *Laurent* nor *Cotteret* provide any evidence of a motivation to make the claimed composition comprised in the kit, as discussed in detail above. Accordingly, this rejection is improper as well and Applicants respectfully request that this rejection be withdrawn.

III. Conclusion

In view of the above remarks, Applicants request reconsideration and reexamination of the application and the timely allowance of the pending claims.

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If there are any additional fees due in connection with the filing of this
Response, please charge the fees to our Deposit Account No. 06-0916.

Respectfully submitted,

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